

REMARKS

This response is submitted in response to the Office action dated October 28, 2004. Notice of Non-Compliant Amendment dated July 2, 2004. In this paper, only claim 21 is amended. Specifically, the preamble of claim 21 is amended to recite "an espresso-type coffee maker of the type having a spout to deliver heated water," to obviate the Examiner's ground for restricting the claims between Groups I and II, as discussed more fully below. In view of the foregoing amendment and following remarks, reconsideration and allowance of claims 1-8, 10-12, 14-21, and 23-28 are respectfully requested.

The most recent Office action presents new grounds for restricting the claims between Group I (including claims 1-8, 10-12, and 14-20) and Group II (including claims 21 and 23-28). Specifically, the Office action asserts that the Group I and Group II are related as combination and subcombination. In particular, the Office action states that "the combination as claimed does not require the particulars of the subcombination as claimed because the layer of filter paper is not required to have a size and shape to fit over and adjacent a top of a permanent filter. The office action further states that the subcombination has separate utility, such as "with a coffee maker not requiring a spout for delivery." The office action further alleges that applicant has received an action on the merits for the originally presented invention, and therefore applicant has constructively elected claims 1-20 for prosecution on the merits, thereby withdrawing claims 21-28 from consideration.

Applicant traverses the restriction requirement in view of the claims as amended herein. Independent claim 21 has been amended to recite that the espresso-type coffee maker is "of the type having a spout to deliver heated water." Accordingly, claims 21 and 23-28 do not have separate utility for use with a coffee maker not requiring a spout for delivery, as asserted in the Office action. Consequently, the claims of Groups I and II no longer satisfy the second prong of distinctness for a combination and subcombination as required under MPEP 806.05(c), and therefore the restriction requirement must be withdrawn.

With regard to the Office action comments regarding 37 CFR 1.178, applicant has previously forwarded original U.S. Patent No. 6,016,740 with the Amendment dated January 24, 2003. Applicant specifically requests that the Examiner acknowledge receipt of the original patent document.

The Office action further objects to the specification under 35 U.S.C. 132. Specifically, the Examiner asserts that the following changes to the specification are not supported by the original disclosure:

Substitution of "permanent" for "metallic";
Insertion of "permanent filter" at col. 2, line 30 and col. 3, line 41;
Substitution of "and the like" for "etc" at col. 1, line 62;
Substitution of "reduce" for "rid" at col. 2, line 26;
Insertion of "generally designated 9" at col. 3, line 34; and
Recitation of "elevated" as opposed to "3 to 15 bars".

The Examiner concludes that these changes are new matter without offering any support as to how this conclusion is reached.

While Applicant questions the propriety of the objection, the amendments to the specification presented herewith remove all of the offending proposed changes. While Applicant does not believe the proposed amendments to the specification at issue introduce new matter, they are hereby withdrawn solely to advance prosecution of the application. This amendment should not be interpreted as acquiescing to the objection. Accordingly, the objection to the specification must be withdrawn.

The Office action further rejects claims 1-8, 10-12, and 14-20 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner rejects claims 1 and 17 for reciting a "permanent filter" and claims 4, 7, and 17 for reciting an "elevated pressure." In support of the first ground of rejection, the Examiner alleges that:

The presence of the term "permanent" in patented claims 4 and 7 does not provide adequate support for its addition to the specification and claims. A review of paper #11 (interview summary) in patent application 08/977,997 gives a clear indication that entry of the term "permanent" in patented claims 4 and 7 was by error. The specification at no location provides support for having a permanent filter.

With regard to the second ground of rejection, the Examiner asserts that:

The language found at column 3, lines 36 and 37 of the patented application, the water is delivered "under pressure" is not sufficient support for changing the pressure range from "3 to 15 bars" to "elevated". Nor does it provide support for having an "elevated pressure".

From this, the Examiner concludes that the offending claim language is considered new matter and therefore violates the written description requirement.

The rejections asserted under 35 U.S.C. 112, first paragraph, are traversed for several reasons. First, the rejections are incomplete in that they fail to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. Second, the amended claim language is sufficiently supported by the original specification. Consequently, these rejections must be withdrawn.

The following remarks address the rejections based on the original language of the specification. Accordingly, Applicant does not rely on the proposed amendments to the specification for support of the claims now pending.

The claim rejections suggested in the Office action are incomplete and must be withdrawn. It is clear from section 2163.04 of the MPEP that the Examiner has the initial burden of establishing a lack of written description conclusion. The Examiner must set forth specific findings, namely:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facia case* by **providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.**

MPEP § 2163.04 (emphasis added)

The rejections as asserted in the Office action fail to meet this second requirement.

The rejection of claims 1 and 17 based on recitation of the “permanent filter” is incomplete and therefore must be withdrawn. In making this rejection, the Examiner simply concludes that the recitation is “considered new matter not having support in the specification.” For support of this rejection, the Examiner opines that the presence of the term “permanent” in patented claims 4 and 7 was by error, and again repeats the bald conclusion that the specification “at no location provides support for having a permanent filter.” Neither of these points raised by the Examiner in support of the rejection establishes a *prima facia case* for lack of written description. At no point does the Examiner allege, let alone provide reasons why, a person skilled in the art would not recognize that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed, as specifically required in the MPEP. Accordingly, this rejection is incomplete, improper, and must be withdrawn.

In addition, the Examiner's interpretation of the interview summary offered in support of the rejection is simply wrong. The interview summary, which is paper #11 in U.S. Patent Application Serial No. 08/977,997, states:

Amendments to claims 5, 6, and 9 make claims allowable on the contention that the term "permanent" can be changed to "metallic" by examiners amendment if deemed necessary after a further search.

In making the current rejection, the Examiner alleges that this passage from the interview summary "gives a clear indication that entry of the term "permanent" in patented claims 4 and 7 was by error." The Examiner's interpretation of the interview summary is subjective and contrary to the plain meaning of the words of the interview summary.

Specifically, the interview summary does not refuse entry of the proposed amendments, but simply suggests that entry may be refused at some point in the future. Since the claims issued with the term "permanent," Applicant can only conclude that, at that time, the Examiner found no basis to bar entry of the amendments. Furthermore, the interview summary does not suggest that the inclusion of the term "permanent" somehow created a written description issue. Instead, it mentions a "further search," which would suggest that the only issue that would bar entry of the claim amendments would be based on prior art uncovered during an additional search. There is simply no evidence in the record, and particularly in the interview summary, that supports the Examiner's theory that inclusion of the term "permanent" in the patented claims was by error. The Examiner's current attempt to conclude otherwise is simply fabrication.

The rejection of claims 4, 7, and 17 for reciting "elevated pressure" is also incomplete and must be withdrawn. In making this rejection, the Examiner again simply concludes that the recitation is "considered new matter not having support in the specification." The Examiner notes that the disclosure of a coffee maker that delivers hot water "under pressure", which appears at column 3, lines 36 and 37 of the patented application:

[I]s not sufficient support for changing the pressure range from "3 to 15 bars" to "elevated". Nor does it provide support for having an "elevated pressure".

Again, the supposed support for the Examiner's rejection consists entirely of bald conclusions that the specification fails to provide support for the proposed claim language. At no point does the Examiner acknowledge the proper standard, let alone apply that standard, to establish a *prima facia* case for lack of written description. Specifically, the

Examiner's comments fail to provide reasons why a person skilled in the art would not recognize that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed, as explicitly required in the MPEP. This ground of rejection must therefore be withdrawn.

Even if the deficiencies in the 35 U.S.C. 112, first paragraph, rejections are ignored, claims 1, 4, 7, and 17 are fully and adequately described in the specification. It is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of 35 U.S.C. 112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("the claimed subject matter need not be described *in haec verba* in the specification in order for that specification to satisfy the description requirement"). The written description requirement of 35 U.S.C. 112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by § 112"). Rather than requiring literal support in the specification, the proper standard is based on what the specification conveys to one skilled in the art. As stated in Lampi Corp. v. American Power Products, 56 U.S.P.Q.2d 1445, 1455 (Fed. Cir. 2000) (citation omitted):

In order to satisfy the written description requirement, the disclosure as originally filed need not provide *in haec verba* support fro the claimed subject matter at issue. The requirement is met if 'the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'

Under the appropriate standard stated above, the originally filed specification provides sufficient support for claims 1, 4, 7, and 17.

The term "permanent filter" as recited in claims 1 and 17 finds ample support in the specification as filed. In describing the type of coffee maker in which the claimed filtering device is to be used, the original specification identifies the metallic filter 18 as being of a type known in espresso makers. Specifically, at column 3, lines 41 to 46, and with reference to FIG. 1, the original specification discloses that:

The filtering device 10 has a holding pan 16, which receives a perforated metallic filter 18 of known type in espresso-type makers. The holding pan 16 may have a rubber O-ring 20 to sealingly engage against an outer surface of the metallic filter

18 and ensure that the hot water is pumped through the coffee CG and filters under pressure.

The specification further discloses that the metallic filter 18 remains in the pan even when it is removed from the coffee maker and inverted. At column 4, lines 30-37, the specification states:

It should now be clear that an espresso coffee machine has been described which is easy to use and to clean. The filter fits quickly and easily into the holding pan on top of the pre-existing metallic filter. After the coffee grounds are spent, a tap on the holding pan held upside-down over a refuse container sends the charge of coffee grounds with the paper filter (which form a cake) into said refuse container, with no residue left in the pan.

The first passage reproduced above conveys to one of ordinary skill in the art that the metallic filter 18 is of a known type used in espresso-type coffee makers. As such, one skilled in the art would recognize the filter disclosed in U.S. Patent No. 5,447,631, which is described as a "permanent filter", as a known type. Furthermore, the skilled artisan would know that most previous filters provided in espresso-type coffee makers are permanent in the sense that they are intended to be reused during several brewing operations, in contrast to the paper filter disclosed and claimed in the application, which is disposable. This is further amplified by the second passage reproduced above, which discloses that only the disposable filter and coffee grounds are discharged into a refuse container when the pan is inverted, thereby implying that the "pre-existing" metallic filter remains with the pan. Accordingly, the specification as filed would reasonably convey to one skilled in the art that Applicant, at the time the application was filed, contemplated use of the paper filter in an espresso-type coffee machine having a permanent filter, and therefore inclusion of the term "permanent" in claims 1 and 17 finds sufficient support.

The term "elevated pressure" as recited in claims 4, 7, and 17 also finds sufficient support in the original specification. Several instances throughout the specification note that an espresso-type coffee maker delivers hot water at "3 to 15 bar" (column 1, line 14) or "under pressure" (column 2, line 44; column 3, lines 36-37). One of ordinary skill in the art would, on a broad level, understand from this language in the specification that the water pressure is elevated with respect to normal atmospheric pressure. Thus, the specification as filed would reasonably convey to one skilled in the art that Applicant, at the time the application was filed, contemplated use of the paper filter in an espresso-type coffee machine

capable of delivering water at an elevated pressure, and therefore inclusion of the term "elevated" in claims 4, 7, and 17 finds sufficient support.

The Examiner incorrectly alleges that the disclosure of water "under pressure" is not sufficient support for claiming an "elevated pressure." By so arguing, the Examiner improperly requires literal support for the claim term at issue. As noted above, it is well settled that such literal, or *in haec verba*, support is not necessary to satisfy the written description requirement.

In view of the foregoing amendments and remarks, it is submitted that claims 1-8, 10-12, 14-21, and 23-28 as now appearing in this application are in good and proper form for allowance. A favorable action on the part of the examiner is respectfully solicited.

If, in the opinion of the examiner a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,

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